



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,393	12/23/1999	JAN STENSBORG	0459-0386P	7348

7590 07/26/2005

BIRCH STEWART KOLASCH & BIRCH LLP
PO BOX 747
FALLS CHURCH, VA 220400747

EXAMINER

JACKSON, MONIQUE R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/471,393

Applicant(s)

STENSBORG ET AL.

Examiner

Monique R. Jackson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 73,75-82,84-100,102-108,110-113 and 115-128 is/are pending in the application.
- 4a) Of the above claim(s) 91-96,102-104 and 116-122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 73,75-82,84-90,97-100,105-108,110-113,115 and 123-128 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/05 & 5/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1773

DETAILED ACTION

1. The amendment filed 5/9/05 has been entered. Claim 114 has been canceled. Claims 73, 75-82, 84-100, 102-108, 110-113, and 115-128 are pending in the application. Claims 91-96, 102-104, and 116-122 have been withdrawn from consideration.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 73, 75-82, 90, 97-100, 105-108, 111, 113, 115, and 123-124 are rejected under 35 U.S.C. 102(b) as being anticipated by Bussard (USPN 5,281,499) for the reasons recited in the prior office action and restated below wherein the Examiner takes the position that the metal substrate taught by Bussard to which the holographic image is adhered reads upon the instantly claimed metal substrate, i.e. "the metal substrate is an integrated part of a container" considering the instant invention provides no structural limitations with regards to the "container" to differentiate the instantly claimed metal substrate from the metal substrate taught by Bussard and considering the invention taught by Bussard is capable of being an integrated part of a container.

Bussard teaches an interface assembly comprising a substrate such as a metal substrate, a transparent polymer film having a holographic or a diffraction grating image embossed thereon adhered to the substrate, such as a metal substrate (*Col. 5, lines 23-25 which is equivalent to the holding metal substrate of the instant invention*) via an adhesive silk screen printing ink between the substrate and the film (equivalent to the color layer of the instant invention) whereby the printed design on said substrate cooperates with the image on said film to provide a total graphic and wherein the hologram or diffraction grating image includes a reflective metallized layer,

Art Unit: 1773

preferably aluminum (Abstract; Figures; Col. 2, lines 55-60; Col. 3, lines 39-56; Col. 4; Col. 5, lines 15-23; Claims, particularly Claim 23.) Bussard further teaches that the embossed plastic film may further include a tint or dye lacquer layer to provide a colored holographic foil or may further include additional layers of various material commonly found in holographic products (Col. 4, lines 1-20.) The assembly further includes a transparent water permeable seal layer at the perimeter of the layered article thereby protecting the embossed surface that produces the holographic image or iridescent diffraction grating pattern (Abstract; Col. 9-10.) Bussard teaches that the holographic or diffraction grating image can be formed by conventional methods such as a stamping process with a stamping die whereby the plastic layer itself may be embossed followed by metal coating on the embossed surface (Col. 3, line 65-Col. 4, line 26.)

4. Claims 73, 75-82, 90, 97-100, 105-108, 111, 113, 115, and 123-124 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al (USPN 4,856,857.) Takeuchi et al teach a transparent hologram comprising a transparent hologram-forming layer holding a surface relief pattern and a holographic effect-enhancing layer comprising a thin transparent film, wherein the holographic effect-enhancing layer has a refractive index different from that of the transparent hologram-forming layer (Abstract; Figures.) Takeuchi et al further teach that the transparent hologram can be provided on a base sheet 64 such as a metal plate or foil as in Figure 7 or on a substrate 70 such as a sheet or foil of various materials including metals and metal alloys, wherein embodiments taught by Takeuchi et al read upon the instantly claimed layers (Col. 15, lines 48-54; Col. 17, lines 60-65; Col. 19, lines 1-45; Figures 1-3, 7, 10, 13.) Takeuchi et al also teach that a color or print layer may be provided between the transparent hologram and the base sheet or the substrate to provide decorative effects (Col. 3, lines 42-65; Col. 18, lines 23-31;

Art Unit: 1773

Figures.) Takeuchi et al teach that the substrate upon which the hologram is to be formed includes packages such as cartons and containers and liquid containers as instantly claimed (Col. 20, lines 21-45.) Takeuchi et al also teach that the surface relief pattern can be formed by a method known in the art such as a stamping process as instantly claimed (Col. 6, lines 53-64.)

Claim Rejections - 35 USC § 103

5. Claims 84-89, 110, 112, and 125-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bussard. The teachings of Bussard are discussed above. Though Bussard teaches that the plastic layer may be embossed by known methods of producing a holographic or diffraction grating image such as by a stamping process, Bussard does not specifically teach a rolling process however a rolling process is a conventional and equivalent method to a stamping process to produce a holographic surface relief and would have been obvious to one having ordinary skill in the art at the time of the invention. With respect to the thickness of the plastic layer holding the stamped image, though Bussard does not specifically teach the thickness ranges as instantly claimed, it is well established in the art that the thickness of the layer is a result-effective variable wherein one skilled in the art at the time of the invention would have been motivated to determine the optimum thickness to hold a particular surface relief pattern.

6. Claims 84-89, 110, 112, and 125-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al. The teachings of Takeuchi et al are discussed above. Though Takeuchi et al teach that the holographic image can be produced by known methods in the art such as by a stamping process, Takeuchi et al do not specifically teach a rolling process however a rolling process is a conventional and equivalent method to a stamping process to produce a holographic surface relief and would have been obvious to one having ordinary skill in the art at

Art Unit: 1773

the time of the invention. With respect to the thickness of the plastic layer holding the stamped image, though Takeuchi et al do not specifically teach the thickness ranges as instantly claimed, it is well established in the art that the thickness of the layer is a result-effective variable wherein one skilled in the art at the time of the invention would have been motivated to determine the optimum thickness to hold a particular surface relief pattern.

Response to Arguments

7. Applicant's arguments filed 5/9/05 have been fully considered but they are not persuasive. The Examiner notes that the Applicant has incorrectly equated the metal backing layer taught by Bussard to the metal substrate of the instant invention and that the Applicant has narrowed the invention taught by Bussard to fabric substrates only, particularly T-shirts. First, the Examiner notes that T-shirts are in fact a preferred embodiment of Bussard but that Bussard further teach that the fabric embodiments may also include tote bags which would read upon the instantly claimed "container". However, the Examiner notes that the rejection as previously stated in the prior office action and restated above, clearly refers to the metal substrate taught by Bussard, refer to Col. 5 and the Figures, not the "metal backing layer", and hence it is unclear how the Applicant incorrectly interpreted the teachings of the reference or the rejection. Further, as stated above, the Examiner notes that the limitation with regards to "the metal substrate is an integrated part of a container" provides no structural limitations with regards to the "container" to differentiate the instantly claimed metal substrate from the metal substrate taught by Bussard and hence constitutes intended use of the metal substrate. Therefore, considering the invention taught by Bussard is capable of being an integrated part of a container, the Examiner takes the position that the invention taught by Bussard reads upon the instant claims.

Art Unit: 1773

8. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 5/9/05 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson
Primary Examiner
Technology Center 1700
July 25, 2005